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09/576,245	05/24/2000	Shin Muto	35.C14506	4825

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EXAMINER

HAMILTON, MONPLAISIR G

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 05/23/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/576,245

Applicant(s)

MUTO ET AL.

Examiner

Monplaisir G Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-15, 17-23 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15, 17-23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

1. Claims 1-7, 9-15 and 17-23 were pending. The communication filed on 3/12/03 amended Claims 1-3, 6-7, 9-15 and 17-23, and added new Claims 25-27. Claims 1-7, 9-15, 17-23 and 25-27 remain for examination.

### ***Continued Prosecution Application***

2. The request filed on 3/12/03 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/576245 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Response to Arguments***

4. Applicant's arguments with respect to Claims 1-7, 9-15, 17-23 and 25-27 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 6, 9, 14, 17, 22, 26 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. These claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has successfully invoked 112 ¶ 6, unfortunately the original disclosure does not support the claimed second search means, second search step, and second search computer. The original disclosure as filed describes only one search process/means/computer/step that processes plural search conditions (Specification: page 11-13; Fig 5). It is unclear which section of the original disclosure describes the claimed second search process/means/computer/step. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 9, 17 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6477589 issued to Suzuki et al, herein referred to as Suzuki.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Referring to Claims 1, 9, 17 and 26:

Suzuki discloses a device searching apparatus that searches for at least one device on a network, comprising: input means for entering a first search condition and a second search condition in order to search for a desired device on the network (Fig 26; col 19, lines 25-30); first search means for searching for at least one device that satisfies the first search condition entered by using said input means; second search means for searching for at least one device that

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satisfies the second search condition entered using said input means (Fig 29; col 20, lines 58-65); output means for outputting a search result based on searches by said first search means and said second search means, wherein said output means outputs the search result such that a device that satisfies the first search condition may be discriminated from a device that satisfies the second search condition (col 20, lines 60-65; Fig 42; col 55-65; ).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 9, 17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6342971 issued to Owa et al, herein referred to as Owa in view of US 6295527 issued to McCormack et al, herein referred to as McCormack.

Referring to Claims 1, 9, 17 and 26:

Owa discloses a device searching apparatus that searches for at least one device on a network, comprising: input means for entering a first search condition and a second search condition in order to search for a desired device on the network (col 4, lines 25-35; col 4, line 65- col 5, line 25); first search means for searching for at least one device that satisfies the first search condition entered by using said input means (col 5, lines 45-55); second search means for searching for at least one device that satisfies the second search condition entered using said input means (col 6, lines 5-20).

Owa does not explicitly disclose an “output means for outputting a search result based on searches by said first search means and said second search means, wherein said output means outputs the search result such that a device that satisfies the first search condition may be discriminated from a device that satisfies the second search condition.”

McCormack discloses output means for outputting a search result based on searches by said first search means and said second search means, wherein said output means outputs the search result such that a device that satisfies the first search condition may be discriminated from a device that satisfies the second search condition (Fig 3; Fig 5; col 16, line 60- col 17, line 15).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Owa to output the results of the search. One of ordinary skill in the art would have been motivated to do this because it would allow the user to select the best device.

Referring to Claims 2, 10 and 18:

Owa in view of McCormack disclose the limitations as discussed in Claims 1, 9 and 17 above. McCormack further discloses first search means performs a first search based on an inputted value representing a plurality of functions, said second search means performs a second search based on an inputted value representing a plurality of functions, the inputted value being inputted independently of the inputted value used by said first search means (col 13, lines 45- col 14, line 62), and said output means distinguishably displays a search result of said first search means and a search result of said second search means on a display unit (Fig 3; Fig 5; col 16, line 60- col 17, line 15).

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Referring to Claim 3:

Owa in view of McCormack disclose the limitations as discussed in Claim 2 above.

McCormack further discloses communication means for acquiring device information, registered corresponding to identification information in another apparatus on the network, from the other apparatus (col 16, line 60- col 17, line 15), wherein said control means controls said communication means to acquire additional information on each device identified in the search result, and causes the additional information to be added to the search result (Fig 3; Fig 5; col 16, line 60- col 17, line 15).

Referring to Claims 4, 12 and 20:

Owa in view of McCormack disclose the limitations as discussed in Claims 3, 11 and 19 above. McCormack further discloses said control step includes acquiring, from an apparatus that manages location information of devices on the network, location information of each device identified in the search result, and adding the location information to the search result (col 10, lines 60-65).

Referring to Claims 11 and 19:

Owa in view of McCormack disclose the limitations as discussed in Claims 10 and 18 above. McCormack further discloses a control step of controlling said output step to output the search result such that the search result includes identification information and attribute information of a device that satisfies at least one of the first search condition and the second search condition (Fig 3; Fig 5; col 16, line 60- col 17, line 15); and a reception step of receiving



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device information, registered corresponding to identification information in another apparatus on the network, from the other apparatus, wherein said control step controls said reception step to acquire additional information on each device identified in the search result, and cause the addition information to be added to the search result (col 16, line 60- col 17, line 15).

8. Claims 5, 13 and 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iizuka and Gregerson as applied to Claims 1-4, 9-12, 17-20 and 26above, and further in view of Network Design Manual *The Future of Enterprise Printing*, herein referred to as Enterprise Network Printing.

Referring to Claim 5, 13 and 21:

Owa in view of McCormack disclose the limitations as discussed in Claims 3, 11 and 19 above.

Owa in view of McCormack do not explicitly disclose the claimed “acquiring from an apparatus that manages charge information of devices on the network, charge information of each device identified in the search result, and to add the charge information to the search result”.

Enterprise Network Printing discloses that a user can be billed for usage of the printer (page 1, lines 13-18).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Owa in view of McCormack to provide a billing mechanism. One of ordinary skill in the art would have been motivated to do this because

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it would allow users to determine the cost information of a printer before printing to it (page 1, lines 13-15).

9. Claims 6-7, 14-15, 22-23 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6342971 issued to Owa et al, herein referred to as Owa in view of US 6369909 issued to Shima, herein referred to as Shima.

Referring to Claims 6, 14, 22 and 27:

Owa discloses a device searching apparatus that searches for at least one device on a network, comprising: management means for managing a database that includes identification information for identifying a device on the network and static information associated therewith (col 8, lines 14-25); input means for entering a first group of attributes and a second group of attributes for searching for at least one desired device on the network (col 4, lines 25-35; col 4, line 65-col 5, line 25); first search means for searching for at least one device from the database having the first group of attributes entered using said input means (col 5, lines 45-55); second search means for searching for at least one device that satisfies the second search condition entered using said input means (col 6, lines 5-20); output means for outputting a search result that includes identification information of static information of a device having at least one of the first and second groups of attributes (col 6, line 65- col 7, line 10); control means for adding dynamic information to the search result, according to a number of devices having at least one of the first and second groups of attributes; and discrimination means for discriminating a device

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with a high frequency of use, based on dynamic information, which relates to a use history of devices on the network (col 7, lines 1-10).

Owa does not explicitly disclose “wherein, in a case which a number of devices having first group attributes is zero, said control means adds to the search result information of the device with the high frequency of use discriminated using said discrimination means.”

Shima discloses wherein, in a case which a number of devices having first group attributes is zero, said control means adds to the search result information of the device with the high frequency of use discriminated using said discrimination means (col 15, lines 49-55).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Iizuka to provide a mechanism for setting a default device as the device whose frequency of use is the most. One of ordinary skill in the art would have been motivated to do this because it would provide the user with a device that would be the most suitable to complete the print job (col 15, lines 48-51).

Referring to Claims 7, 15 and 23:

Owa in view of Shima disclose the limitations as discussed in Claim 6 above. Owa further discloses a case in which the number of devices identified in the search result is at least equal to a predetermined value, said control means acquires dynamic information from a device having at least one of the first and the second groups of attributes and adds the dynamic information to the search result (col 7, lines 1-10).

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Referring to Claim 25:

Owa in view of Shima disclose the limitations as discussed in Claim 6 above. Owa further discloses first group of attributes used by said first search means includes at least one of color, double side and staple (col 5, lines 1-10); said output means outputs to a display unit (col 12, 35-40), and said first search means and said second search means search for devices having the first group of attributes and the second group of attributes, respectively, in accordance with a search instruction inputted by a user, such that found devices are automatically displayed on the display unit as list (col 12, lines 35-45; col 14, lines 45-50).

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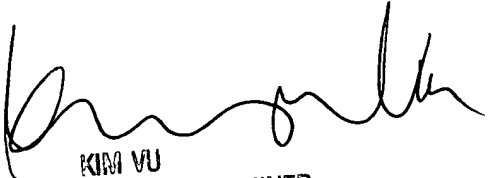
*Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monplaisir G Hamilton whose telephone number is 1703-305-5116. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on 1703-305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are 1703-746-7239 for regular communications and 1703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 1703-305-3900.

Monplaisir Hamilton  
May 8, 2003

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
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